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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/606,123 | 06/26/2003 | Teruaki Shinohara | 045237-0121 | 3651 |
| 22428 | 7590 | 12/20/2005 | EXAMINER | |
| FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | ROBINSON, MARK A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2872 | |

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

10/606,123

Applicant(s)

SHINOHARA, TERUAKI

Examiner

Mark A. Robinson

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 2, 3, 5-8, 11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2872

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/05 has been entered.

Claim Objections

2. Claim 7 is objected to because of the following informalities. Appropriate correction is required.

This claim recites "a second fixing unit." However, no "first fixing unit" was recited. It is improper to recite a "second" such unit without previously reciting a "first" such unit.

Art Unit: 2872

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13,2,3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoek (US 6116743).

Regarding claim 13, Hoek shows a mirror apparatus including housing(18), base(68), unit bracket(16,24), and mirror unit(20), wherein the housing, base and unit bracket are separately formed, the housing has two openings, the base has a base portion, first mounting portion(76) for attachment to a vehicle and second mounting portion(80) on another side for mounting the unit bracket, the unit bracket has first mounting portion (32) for mounting the housing and mirror unit and a second mounting portion(16) protruding from the second opening in the housing and mounted (at 60) to the second portion of the base and forming, along with the second mounting portion of the base, a narrow neck (see figs. 2,5), wherein the mirror housing is free of a neck portion that protrudes out from the general shape of

Art Unit: 2872

the mirror housing (see fig. 6 which shows the right side of the housing to be free of any neck portion).

Regarding claim 2, note that mounting axes of the base portions are near each other and are parallel (they are both vertically oriented).

Regarding claim 3, Hoek's mounting arrangement is shown to be "suspended."

Regarding claim 5, Hoek's springs(88,98,100) function as a "backlash prevention unit" located in one of the claimed locations.

Regarding claims 6 and 7, Hoek shows a positioning unit (the hinge structure between 16 and 80) which fixes the second mounting portions of the base and unit bracket. This positioning unit includes structure which satisfies "first positioning unit" and "second fixing unit" since the elements of the hinge structure prevent relative movement of the base and unit bracket in both the up/down direction and the lateral in/out direction.

Regarding claim 8, Hoek teaches flat surfaces on an entire circumference of the second opening(54) which touch flat surfaces of the second portion(16) of the mounting bracket (see figs. 5,6).

Art Unit: 2872

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoek.

Hoek meets the limitations of claim 11 as discussed above, but does not teach portions painted with different colors. However, it is very well known to use such a painting scheme on a vehicle mirror device. It would have been obvious to the ordinarily skilled artisan at the time of invention to paint the portions of the housing near the opening a different color than that of the base and unit bracket to improve the appearance of the device.

7. Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoek in view of either Croteau (US 5096283) or Hou (US 4998812).

Art Unit: 2872

The limitations of these claims are either met by or obvious over Hoek as discussed above, except that Hoek does not show the second opening to be in a side surface of the housing that is substantially planar as set forth in claim 14. However, such an arrangement is shown by either Croteau (note the right side of frame 12 in fig. 1) or Hou (note planar side wall 501). It would have been obvious to the ordinarily skilled artisan at the time of invention to modify the shape of Hoek's side surface to be planar as shown by Croteau or Hou in order to accommodate a particular vehicle design depending on the particular spatial constraints of said design.

Allowable Subject Matter

8. Claim 4 is allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the

Art Unit: 2872

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

12/16/05


MARK A. ROBINSON
PRIMARY EXAMINER